

REMARKS

Claims 1-10 and 14-25 are pending in this application, all of which have been amended.

Claims 11-12 are withdrawn from consideration. No new claims have been added.

The claims have been amended to address all of the 35 U.S.C. § 112, first and second paragraph, rejections.

Claims 1-10, 15-17 and 24-25 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 5,993,631 to Parton et al. (hereafter, "**Parton et al.**").

Applicants respectfully traverse this rejection.

In **Parton et al.**, four voltages of different phase shifts (kinds) must be applied to at least four pairs of electrodes. In contrast, in the present invention, only one kind of voltage is applied, which prevents the generation of a traveling wave. Page 27, lines 21-23 of the specification of the instant application disclose that either AC or DC voltage may be applied, where the AC voltage has a specific frequency and electric field strength.

Accordingly, the claims have been amended to recite this distinction. Furthermore, in **Parton et al.**, negative dielectrophoresis force is used only to draw apart molecules from electrodes and it has been disclosed that molecules which are drawn apart from electrodes can be separated by the traveling wave process.

Therefore, according to the disclosure in **Parton et al.**, one of ordinary skill in the art should understand that separation of molecules needs at least two factors such as (a) a traveling wave and (b) the dielectrophoresis force to be combined with the traveling wave should be negative. In other words, (i) molecules cannot be separated without the traveling wave, and (ii) even if the traveling wave is used, molecules cannot be separated if the dielectrophoresis force combined with the traveling wave is positive.

Preliminary Amendment
U.S. Patent Application Serial No. 09/670,399

The claims have also been amended to recite this distinction.

Thus, the 35 U.S.C. § 102(e) rejection should be withdrawn.

Claims 1-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,294,063 to Becker et al. (hereafter, "**Becker et al.**").

Applicants respectfully traverse this rejection.

Becker et al., like **Parton et al.**, fails to teach, mention or suggest the newly recited limitations added to the claims via the aforementioned amendments.

Thus, the 35 U.S.C. § 102(e) rejection should be withdrawn.

A telephonic interview was conducted with the Examiner on August 15, 2006 and proposed claim amendments were presented along with patentability arguments. The Examiner indicated that these proposed claim amendments, as presented above, would overcome the 35 U.S.C. § 112, first and second paragraph rejections, as well as the 35 U.S.C. § 102(e) rejections.

However, the Examiner also indicated that the additional proposed claim limitations of "supplying only one kind of voltage, which is either an AC electric field or a DC electric field" and "having an electric field strength of 500 kV/m to 10 MV/m" present new issues and would not be entered unless an RCE is filed and a new prior art search conducted.

The above amendments are believed to place the claims in proper condition for further examination. Early and favorable action is awaited.

Preliminary Amendment
U.S. Patent Application Serial No. 09/670,399

In the event that any fees are due in connection with this paper, please charge our
Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS,
HANSON & BROOKS, LLP



William L. Brooks

Attorney for Applicant

Reg. No. 34,129

WLB/ak

Atty. Docket No. **001268**

Suite 1000

1725 K Street, N.W.

Washington, D.C. 20006

(202) 659-2930



23850

PATENT TRADEMARK OFFICE

Enclosures: Petition for Extension of Time
 Request for Continued Examination Transmittal
 Check in the amount of \$1,810.00

Q:\HOME\AKERR\WLB\00\001268\prelim amend aug 2006